

INDEX

	Page
Opinions below	1
Jurisdiction	2
Question presented	2
Statute involved	2
Statement	4
Specification of errors to be urged	5
Reasons for granting the writ	6
Conclusion	14

CITATIONS

Cases:

<i>Alexandrine v. Coe</i> , 71 F. 2d 348	11
<i>American Steel Foundries v. Robertson</i> , 262 U. S. 209	7
<i>Barrett Co., et al. v. Ewing, Commissioner of Patents</i> , 242 Fed. 506, certiorari denied, 244 U. S. 661	9
<i>Baldwin Co. v. Robertson</i> , 265 U. S. 168	7
<i>Botany Worsted Mills v. Commissioner of Patents</i> , Civil No. 2746-48 (D. C. D. C.)	12
<i>Botany Worsted Mills v. S. L. Peacock</i> , Civil No. 11479 (D. C. N. Y.)	12
<i>Butler v. Shaw</i> , 21 Fed. 321	13
<i>Century Distilling Co. v. Continental Distilling Co.</i> , 106 F. 2d 486, certiorari denied, 309 U. S. 662	6, 7, 8, 10
<i>Cleveland Trust Co. v. Nelson, et al.</i> , 51 F. 2d 276	9
<i>Colby, George E. and Elmwood Braid Co. v. Comm. of Patents</i> , Civil No. 4605-48 (D. C. D. C.)	14
<i>Colby, George E. and Elmwood Braid Co. v. Joseph L. Hunter and Hunter Engineering Co.</i> , Civil No. 8882-BH (S. D. Cal.)	14
<i>Drackett Co. v. Chamberlain Co.</i> , 81 F. 2d 866	10, 11
<i>Eno, J. C. (U. S.) Limited v. Coe</i> , 106 F. 2d 858	11
<i>Fessenden v. General Electric Co.</i> , 10 F. Supp. 846	13
<i>Gandy v. Marble</i> , 122 U. S. 432	9
<i>Graham v. Teeter</i> , 25 Fed. 555	13
<i>Hazeltine Corp. v. White</i> , 68 F. 2d 715	13
<i>Hoover Co. v. Coe</i> , 325 U. S. 79	9
<i>Morgan v. Daniels</i> , 153 U. S. 120	13
<i>Old Charter Distillery Co. v. Continental Distilling Corp.</i> , 65 U. S. P. 395	12
<i>Philadelphia Storage Battery Co. v. Zenith Radio Corp.</i> , 117 F. 2d 642	13

II

Cases—Continued

Page

<i>Speed Prod. Co., Inc. v. Tinnerman Prod., Inc.</i> , 73 U. S. P. Q. 181.....	10, 11, 12
<i>Speed Prod. Co., Inc. v. Kingsland, Commissioner of Patents and Tinnerman Products, Inc.</i> , 77 U. S. P. Q. 447	11, 12
<i>Thorne, Neale & Co., Inc. v. Coe</i> , 143 F. 2d 155.....	11
<i>Tomlinson of High Point v. Coe</i> , 153 F. 2d 65.....	11
<i>Warsaw Brewing Corp. v. Kingsland, Commissioner of Patents, and Atlantic Brewing Co.</i> , Civil No. 48 C 1662 (N. D. Ill.).....	12
<i>Warsaw Brewing Corp. v. Kingsland, Commissioner of Patents and Atlantic Brewing Co.</i> , Civil No. 4621-48 (D. D. C.)	12

Statutes:

Lanham Trade Mark Act of July 5, 1946 (60 Stat. 427, 435, 15 U. S. C. 1051-1127.....	13
R. S. 4915, as amended, 35 U. S. C. 63.....	2, 7, 9, 13
United States Code, Title 15, Sec. 85.....	10

In the Supreme Court of the United States

OCTOBER TERM, 1948

No. —

LAWRENCE C. KINGSLAND, COMMISSIONER OF
PATENTS, PETITIONER

v.

BARRON-GRAY PACKING COMPANY

PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE DIS-
TRICT OF COLUMBIA CIRCUIT

The Solicitor General, on behalf of Lawrence C. Kingsland, Commissioner of Patents, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit entered in the above-entitled case on October 12, 1948.

OPINIONS BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals

for the District of Columbia Circuit (R. 12-15) has not yet been reported.

JURISDICTION

The judgment of the Court of Appeals was entered on October 12, 1948 (R. 15). The jurisdiction of this Court is invoked under 28 U. S. C. 1254(1).

QUESTION PRESENTED

Whether an applicant for a trade-mark who has been denied registration, after an opposition proceeding in the Patent Office, because of confusing similarity with a prior trade-mark, may seek review from the courts under Revised Statute 4915 by suit against the Commissioner of Patents alone, without notice to, and without joining as a defendant, the opposing party whose preexisting trade-mark formed the basis for the denial of the application.

STATUTE INVOLVED

Revised Statute 4915, as amended, 35 U. S. C. 63, reads as follows:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy

by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

The Barron-Gray Packing Company adopted and began the use of two trade-marks for fruit juices consisting of pictures of animated apricots and prunes. An application was made in the Patent Office for trade-mark registration. The Commissioner of Patents at first held these trade-marks to be registerable, and they were published in the Official Gazette of the United States Patent Office on December 24, 1940 (R. 2, 9).

Thereafter, opposition to the registration was filed in the Patent Office by Bruce's Juices, Inc., a Florida corporation, claiming that Barron-Gray's trade-marks were similar to its own registered marks, humanized representations of fruit holding tumblers of beverage. Barron-Gray filed answers to such oppositions and thereafter the Commissioner of Patents rendered a decision holding that some likelihood of confusion might exist in the concurrent use of Barron-Gray's trade-marks and Bruce's Juices' trade-marks, and refused registration (R. 2-3, 9).

Barron-Gray filed a bill in equity under R. S. 4915 in the United States District Court for the District of Columbia, against the Commissioner of Patents, alleging that its trade-marks are not similar to those of Bruce's Juices, and that its marks are not calculated to deceive or confuse the public (R. 1-9).

The Commissioner filed a motion to dismiss the suit on the ground that the opposer in the Patent Office was an indispensable party (R. 10). The district court sustained the motion (R. 10). On appeal, the Court of Appeals reversed and remanded the case for trial on its merits (R. 15).

The Court of Appeals held that the opposer is a proper but not an indispensable party. The reasons stated for this conclusion were, "Since the applicant has no power to compel the appearance of a non-resident opposer in a District of Columbia court unless the opposer chooses to appear and intervene, if it be held that the opposer is an indispensable party, as the district court has held in this case, it is obvious that the right of access intended by and provided for by Congress cannot be exercised except by sufferance. On the other hand, the Commissioner of Patents cannot be sued outside the District of Columbia without his consent. It is thus apparent that the net result of ruling that the non-resident opposer is an indispensable party to a 4915 action brought in this jurisdiction against the Commissioner alone would be to completely defeat the intent of Congress to afford the unsuccessful applicant for a trade-mark adequate access to the courts." (R. 13.)

SPECIFICATION OF ERRORS TO BE URGED

The Court of Appeals for the District of Columbia Circuit erred:

1. In holding that the successful opposing party in a trade-mark opposition proceeding is not an indispensable party to further proceedings in the courts under Revised Statute 4915.

2. In assuming that the Commissioner of Patents is an indispensable party to proceedings under R. S. 4915 in all cases.

3. In reversing the judgment of the district court.

REASONS FOR GRANTING THE WRIT

The court below has held, contrary to the decision of the Court of Appeals for the Third Circuit in *Century Dist. Co. v. Continental Dist. Co.*, 106 F. 2d 486, certiorari denied, 309 U. S. 662, that, in a proceeding brought under R. S. Section 4915 to review the action of the Commissioner of Patents in refusing to register a trade-mark after an opposition proceeding in the Patent Office, the Commissioner of Patents, and not the successful opposer in the opposition proceeding, is the indispensable party defendant. The result of this conflict has been, and will probably continue to be, to compel a party, in seeking judicial review under R. S. Section 4915 after a contested proceeding in the Patent Office, either to run the risk of having his action held fatally defective for lack of a necessary party or to initiate two actions in two separate forums on the same issues and seeking the same relief: one against the opposing party in the dis-

trict where he can be reached with process, the other in the District of Columbia where the Commissioner of Patents can be served. The conflict will affect patent cases, perhaps to an even greater extent than trade-mark matters.¹ Clearly, litigation proceeding simultaneously in two courts on identical issues affecting the same parties imposes an excessive burden on both the litigants and the judiciary, and contains always the possibility of a conflict in decisions susceptible of resolution by this Court alone. Yet unless the question as to the proper party against whom proceedings under Section 4915 are to be brought is set at rest by this Court, the conflict between the lower courts will continue to require such double litigation.

1. As respondent expressly conceded in its briefs below (Br. 15-16; Reply Br. 7), the rationale and result in the present case are in square conflict with *Century Distilling Co. v. Continental Distilling Co.*, 106 F. 2d 486 (C. A. 3). Both cases were brought under . . . S. 4915 by an unsuccessful applicant for a trade-mark who had been denied registration, after an opposition proceeding in the Patent Office, on the ground of confusing similarity between the trade-mark for which it was applying and one already held by its opponent. In the

¹ Although phrased solely in terms of patents, R. S. 4915 has long been held equally applicable to trade-marks. *American Steel Foundries v. Robertson*, 262 U. S. 209; *Baldwin Company v. Robertson*, 265 U. S. 168, 179.

Century case, however, the action was brought against the opponent; in this case, against the Commissioner of Patents. The defendant in the *Century* case moved to dismiss on the ground that the failure to join the Commissioner of Patents made the proceedings fatally defective for want of a necessary party. The district court which granted the motion was held to be in error by the appellate court. The action, the Court of Appeals for the Third Circuit held, should have been allowed to proceed even in the absence of the Commissioner; in short, that service of process upon the opponent was sufficient to confer jurisdiction on the court to review the denial of registration to the trade-mark. Here, on the other hand, the court below, rejecting the contention that a suit of this character may not be brought against the Commissioner of Patents alone, expressly assumes the indispensability of the Commissioner of Patents and predicates its decision on the ground that to hold the opponent also to be indispensable "would be to completely defeat the intent of Congress to afford the unsuccessful applicant for a trade-mark adequate access to the courts," (R. 13.) The opinion indicates that the court considers the Commissioner of Patents to be an indispensable party because otherwise the trade-mark applicant would be unable to secure effective relief. "The opposer," the court quotes from an earlier decision, "could not

act to carry out a decree granting such relief" (R. 14).

However, the statute clearly contemplates that actions will be maintainable in the absence of the Commissioner. It provides "In all cases when there is no opposing party a copy of the bill shall be served on the commissioner." Clearly, where there is an opposing party the Commissioner need not even receive notice of the suit, much less be made a party. Moreover, in suits to which the Commissioner is not a party, the statute specifically authorizes official action by him based on an adjudication in such private proceedings, and though not a party to the action, he is bound to respect such judgment.² *Barrett Co., et al. v. Ewing, Commissioner of Patents*, 242 Fed. 506 (C. A. 2), certiorari denied, 244 U. S. 661; *Cleveland Trust Co. v. Nelson, et al.*, 51 F. 2d 276 (E. D. Mich.). See, also, *Gandy v. Marble*, 122 U. S. 432. No greater deference is accorded by the Commissioner to judgments reached in proceedings under R. S. 4915 to which he is a party. Cf. *Hoover Co. v. Coe*, 325 U. S. 79.

The law as it has been developing in trade-mark cases in the federal courts is that the Commissioner of Patents is, or is not, an indispensable party to a proceeding under R. S. 4915 depending upon the character of the decision of the Patent Office which

² "And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law." *Supra*, p. 3.

the court is asked to review. If the trade-mark has been denied registration after opposition proceedings because it was descriptive (15 U.S.C. 85), and not because of any conflict with any other trade-mark, then the Commissioner of Patents is an essential party to any subsequent action. *Drackett Co. v. Chamberlain Co.*, 81 F. 2d 866 (C. A. 3). If, however, registration has been denied, as in this case, simply because of confusing similarity with a prior trade-mark (15 U.S.C. 85), then the action properly proceeds against the opposing party and not against the Commissioner of Patents. *Century Dist. Co. v. Continental Dist. Co.*, 106 F. 2d 486 (C. A. 3); *Speed Prod. Co., Inc. v. Tinnerman Prod., Inc.*, 73 U. S. P. Q. 181 (S. D. N. Y.)

Sound reason supports this distinction. When the trade-mark is denied because it conflicts with another's prior right, the successful opponent can be relied upon to protect whatever public interest may exist by bringing to the attention of the reviewing tribunal the factors militating against registration of the trade-mark. Where, however, the denial of registration is on a ground other than confusing similarity or priority, then self-interest will not coincide with public interest, and the Commissioner should be present to protect the public's right.

Moreover, proceedings under Section 4915 may proceed only "on notice to adverse parties." The

opponent, in a case such as this, in whose favor the Patent Office decided, has been held by at least one court to be an adverse party within the meaning of this statute. *Speed Prod. Co. v. Tinnerman Products, Inc.*, 73 U. S. P. Q. 181 (S. D. N. Y.); cf. *Drackett Co. v. Chamberlain Co.*, 81 F. 2d 866 (C. A. 3); *J. C. Eno (U. S.) Limited v. Coe*, 106 F. 2d 858 (C. A. D. C.). If the statute requires joinder of the opposing party, then to hold, as does the Court of Appeals for the District of Columbia Circuit, that the Commissioner is also indispensable will, in fact, act to deny adequate access to the courts.

These distinctions have been ignored by the court below, whose decision in the instant case crystallizes a continuing tendency to make the Commissioner a party to all actions under R. S. 4915 by applicants whose marks have been refused registration, and to burden the Commissioner with the defense of suits properly the major concern of the successful opposer in the Patent Office proceeding. *Alexandrine v. Coe*, 71 F. 2d 348 (C. A. D. C.); *Thorne, Neale & Co., Inc. v. Coe*, 143 F. 2d 155 (C. A. D. C.); *Tomlinson of High Point v. Coe*, 123 F. 2d 65 (C. A. D. C.); cf. *Speed Products Co., Inc. v. Tinnerman Products, Inc.*, 77 U. S. P. Q. 447 (S. D. N. Y.). Yet the Court of Appeals for the Third Circuit, a court of equal authority with the court below, has held to the contrary, and a lower federal court in another circuit, acting on the authority of the decision of that court, has per-

mitted a suit exactly comparable to this one to proceed in the absence of the Commissioner of Patents. *Speed Prod. Co., Inc. v. Tinnerman Products, Inc.*, 73 U. S. P. Q. 181 (S. D. N. Y.); cf. *Speed Products Co., Inc. v. Kingsland, Comm. of Patents, and Tinnerman Products, Inc.*, 77 U. S. P. Q. 447 (C. A. D. C.).

Meanwhile, private litigants, unable to resolve the conflict, are instituting parallel suits to preserve their rights. Speed Products Co., Inc., an applicant for a trade-mark, denied registration because of confusing similarity to the trade-mark of Tinnerman Products, Inc., instituted action in the District of Columbia against the Commissioner of Patents (*Speed Prod. Co., Inc. v. Kingsland, Comm. of Patents and Tinnerman Products, Inc., supra*) and in the Southern District of New York against its successful opponent. *Speed Prod. Co., Inc. v. Tinnerman Prod., Inc.*, 73 U. S. P. Q. 181. Other trade-mark applicants have done the same. See *Warsaw Brewing Corp. v. Kingsland, Comm. of Patents, and Atlantic Brewing Co.* (N. D. Ill., Civil No. 48 C. 1662) and *Warsaw Brewing Corp. v. Kingsland, Commissioner of Patents, and Atlantic Brewing Co.* (D. D. C., Civil No. 4621-48); *Botany Worsted Mills v. S. L. Peacock* (D. N. J., Civil No. 11479); *Botany Worsted Mills v. Commissioner of Patents* (D. D. C., Civil No. 2746-48); *Old Charter Distillery Co. v. Continental Distilling Corp.*, 65 U. S. P. Q. 395 (D. D. C.). This duplicate and confusing litigation can be ended only by a

definitive interpretation of the statute by this Court.

2. The broad grounds upon which the decision below rests make it applicable to all proceedings under R. S. 4915, patent as well as trade-mark cases. Under the reasoning of the court below, the Commissioner of Patents is an indispensable party to all such actions. Yet the well-established practice in patent cases has been to bring action against the opponent in the Patent Office proceeding, not joining the Commissioner. *Morgan v. Daniels*, 153 U. S. 120; *Butler v. Shaw*, 21 Fed. 321 (C. C. D. Mass.); *Hazeltine Corp. v. White*, 68 F. 2d 715 (C. A. 2); *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, 117 F. 2d 642 (C. A. 7); *Fessenden v. General Electric Co.*, 10 F. Supp. 846 (N.D. N.Y.); *Graham v. Teeter*, 25 Fed. 555 (C. C. E. D. Penn.). This decision casts a cloud on such proceedings, as well as on those involving trade-marks. The Lanham Trade Mark Act of July 5, 1946 (60 Stat. 427, 15 U.S.C. 1051-1127), which specifically provides that the Commissioner of Patents shall not be considered a necessary party to an *inter partes* proceeding under R. S. 4915 (60 Stat. 435, 15 U. S. C. 1071), may act to dispel some of the uncertainty created by this decision in future trade-mark cases,³ but it has no application to patent matters. Applicants for patents may well be com-

³ There is question, however, as to what proceedings involving opposers are "*inter partes*" for the purpose of proceedings under R. S. 4915.

pelled, as are those for trade-marks now, to institute duplicate litigation in the court of their opponent's domicile, in accordance with established practice, and in the District of Columbia, in conformance with the holding of the court below. In at least one case the defeated party in a patent interference has brought suit, under the authority of the opinion below, against the Commissioner of Patents in the District of Columbia and against his real adversary in California. *George E. Colby and Elmwood Braid Co. v. Comm. of Patents*, Civil Action No. 4605-48, filed November 9, 1948; *George E. Colby and Elmwood Braid Co. v. Joseph L. Hunter and Hunter Engineering Co.*, Civil No. 8882-B.H. (S. D. Cal.), filed November 15, 1948.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

PHILIP B. PERLMAN,
Solicitor General.

JANUARY 1949.

FILE COPY

NO. 504.

Office - Supreme Court, U. S.
FILED

MAR 4 1949

CHARLES ELMORE CAUBLE
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1948.

LAWRENCE C. KINGLAND, Commissioner of Patents,
Petitioner,

v.

BARRON-GRAY PACKING COMPANY, *Respondent.*

On Petition for a Writ of Certiorari to the United States
Court of Appeals for the District of Columbia Circuit.

BRIEF FOR THE RESPONDENT IN OPPOSITION.

BALLARD MOORE,
CURTIS F. PRANGLEY,
CHARLES L. STURTEVANT,
Counsel for Respondent.



INDEX TO BRIEF.

	Page
Opinions Below	1
Jurisdiction	2
Question Presented	2
Statutes Involved	2, App. 13
Statement	2
Argument	4
Conclusions	11

CITATIONS.

CASES:

Alexandrine v. Coe, 63 App. D. C. 127, 71 F. 2d 348 (1934)	8
American Steel Foundries v. Robertson, 262 U. S. 209 (1923)	8
Baldwin Co. v. Robertson, 265 U. S. 168 (1924)	8
Century Distilling Co. v. Continental Distilling Co., 106 F. 2d 486 (C. A. 3) (1939), certiorari denied, 309 U. S. 662 (1940)	4, 5, 6
Century Distilling Co. v. Continental Distilling Corp., 23 F. S. 705 (1938)	5
Coe v. Hobart Mfg. Co., 70 App. D. C. 2, 102 F. 2d 270 (1939)	9
Drackett Co. v. Chamberlain Co., 81 F. 2d 866, C. C. A. 3rd (1936)	6, 8
Hamilton-Brown Shoe Co. v. Wolf Brothers & Co., 240 U. S. 251 (1916)	11
Martorelli v. Atlantic Macaroni Co., 111 F. 2d 494, 27 C. C. P. A. (Patents) 1171 (1940)	8
Schering and Glatz, Inc. v. Sharp and Dohme, Inc., 146 F. 2d 1019, 32 C. C. P. A. (Patents) 827 (1944)	8
Speed Products Co., Inc. v. Tinnerman Products, Inc., 73 U. S. P. Q. 181 (1947)	8
Speed Products Co., Inc. v. Tinnerman Products, Inc. and Kingsland, 77 U. S. P. Q. 447 (1948)	8
Thorne, Neal & Co., Inc. v. Coe, 143 F. 2d 155, 79 App. D. C. 122 (1944)	8
Tomlinson of High Point v. Coe, 74 App. D. C. 364, 123 F. 2d 65 (1941)	5, 8
United States Alkali Export Association, Inc. v. United States, 325 U. S. 196 (1945)	11

	Page
STATUTES:	
Title 28, U. S. C., Section 1254(1)	2
Section 737 of the Revised Statutes, 28 U. S. C.,	
Sec. 50	2
Section 5 of the Trade Mark Act of 1905, 15 U. S. C.,	
Sec. 85	2, 7, 10
Section 6 of the Trade Mark Act of 1905, 15 U. S. C.,	
Sec. 86	2, 10
Section 9 of the Trade Mark Act of 1905, 15 U. S. C.,	
Sec. 89	2, 8
Section 4915 of the Revised Statutes, 35 U. S. C.,	
Sec. 63	2, 4, 8, 9, 10, 11
Section 21 of the Trade Mark Act of 1946, 15 U. S. C.	
1071	2, 9, 11

IN THE
Supreme Court of the United States

OCTOBER TERM, 1948.

No. 504

LAWRENCE C. KINGLAND, Commissioner of Patents,
Petitioner,

v.

BARRON-GRAY PACKING COMPANY, *Respondent.*

On Petition for a Writ of Certiorari to the United States
Court of Appeals for the District of Columbia Circuit.

BRIEF FOR THE RESPONDENT IN OPPOSITION.

OPINIONS BELOW.

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 12-15) is reported in 171 F. 2d 576.

JURISDICTION.

The judgment of the Court of Appeals was entered on October 12, 1948 (R. 15). The petition for a writ of certiorari was filed on February 4, 1949. The jurisdiction of this court is invoked under Title 28, U. S. C., Section 1254(1).

QUESTION PRESENTED.

Whether the successful opposer in a Patent Office trade-mark opposition proceeding is an indispensable party to a R.S. 4915 action brought in the District Court against the Commissioner of Patents after the Commissioner has denied registration of the applicant's mark on the ground of confusing similarity to the opposer's registered trade-mark.

STATUTES INVOLVED.

The relevant provisions of Section 737 of the Revised Statutes (28 U.S.C., Section 50); Section 5 of the Trade-Mark Act of 1905 (15 U.S.C., Section 85); Section 6 of the Trade-Mark Act of 1905 (15 U.S.C., Section 86); Section 9 of the Trade-Mark Act of 1905 (15 U.S.C., Section 89); Section 4915 of the Revised Statutes (35 U.S.C., Section 63), and Section 21 of the Trade-Mark Act of 1946 (15 U.S.C. 1071) are set forth in the appendix, *infra*, pp. 13-18.

STATEMENT.

The Barron-Gray Packing Company adopted and began to use as sole and exclusive owner thereof, two trade-marks for canned fruit juices consisting of pictures of animated apricots and prunes toasting each other by holding aloft liquid-containing goblets touching each other. The Commissioner of Patents at first held these trade-marks to be registrable and they were published in the *Official Gazette* of the United States Patent Office on December 24, 1940 (R. 2, 6, and 7).

Thereafter, oppositions to these registrations were filed in the Patent Office by Bruce's Juices, Inc., a Florida corporation, claiming that the Barron-Gray trade-marks were confusingly similar to its registered trade-mark No. 374,765 of January 23, 1940 (R. 2).

Barron-Gray filed answers to such oppositions and thereafter the Assistant Commissioner of Patents rendered a decision holding that some likelihood of confusion might exist in the concurrent use of the Barron-Gray trade-marks and the registered trade-mark of Bruce's Juices (R. 2, 3).

Barron-Gray filed a bill in equity under Section 4915 of the Revised Statutes in the United States District Court for the District of Columbia against the Commissioner of Patents alleging that its trade-marks are not confusingly similar to the registered trade-mark of Bruce's Juices, and that the Barron-Gray marks are not calculated to deceive or confuse the public (R. 1-5).

The Commissioner of Patents filed an answer traversing the allegations of the bill and alleging that the Barron-Gray marks so nearly resemble the registered trade-mark of Bruce's Juices, Inc., as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers, as would appear from the decisions of the Examiner of Interferences and of the First Assistant Commissioner in the opposition proceedings in the Patent Office.

Thereafter the Commissioner of Patents filed a motion to dismiss the action on the ground that the opposer in the antecedent Patent Office proceedings was an indispensable party. The District Court, without statement of reasons, sustained the motion to dismiss (R. 10).

Barron-Gray Packing Company duly appealed to the United States Court of Appeals for the District of Columbia (R. 11). On such appeal the Court of Appeals reversed and remanded the case for trial on its merits (R. 12-15). The reasons stated by the Court of Appeals for its judgment reversing and remanding the case for trial on its merits are clearly set forth in the record (R. 12-15). In its opinion the Court of Appeals noted (R. 14):

"The Commissioner, through his counsel, professes that he has no interest one way or the other in the outcome of this appeal except that he desires that the matter be cleared up and settled by this court."

ARGUMENT.

The question presented to the court by the judgment of the court below is not as broad as that stated by the petitioner on page 2 of its petition. Nor did the court below hold or assume that the Commissioner of Patents is an "indispensable party" to proceedings under R. S. 4915 in all cases, as stated in error in the petition (P. 6).

Although the question presented is whether an opposer in an antecedent Patent Office trade-mark opposition proceeding is an indispensable party to an action under R.S. 4915, allowance of the writ is sought to obtain a decision of this court on another question (not raised below), namely, whether the Commissioner of Patents is a necessary and proper party defendant to such an action.

The reasons advanced by the petitioner for the granting of the writ appear to be:

1. The assumption in the opinion of the Court of Appeals of the District of Columbia Circuit in the instant case that the Commissioner of Patents is a necessary and proper party defendant is in conflict with the rationale of the decision of the Court of Appeals for the Third Circuit in *Century Distilling Co. v. Continental Distilling Co.*, 106 F. 2d 486 (C. A. 3) (1939), certiorari denied, 309 U. S. 662 (1940).

2. The question whether the Commissioner of Patents is a necessary and proper party defendant to an action under R.S. 4915 is one of general importance to the administration of the patent and trade-mark laws.

The petitioner does not contend that the decision of the Third Circuit Court of Appeals in the *Continental Distilling* case is in conflict with decisions of the District of Columbia Court of Appeals, either on the same matter in issue or on the question actually presented by the petition.

The petitioner advances the novel proposition that this court should grant certiorari because the reasoning of the District of Columbia Court of Appeals in the instant case is allegedly in conflict with the reasoning of the Third Circuit Court of Appeals in the Century Distilling case.

In the Century Distilling case (106 F. 2d 486), an applicant for registration of a trade-mark in the Patent Office, who had been defeated in trade-mark opposition proceedings in that Office, brought an action against the successful opposer in the District Court for the Eastern District of Pennsylvania. The defendant filed a counterclaim for trade-mark infringement. The District Court held (*Century Distilling Co. v. Continental Distilling Corp.*, 23 F. S. 705 (1938)), (1) that the plaintiff could not maintain the action because the Commissioner of Patents was an absent, indispensable party, and (2) the mark of the plaintiff was confusingly similar to the mark of the defendant. On appeal to the Third Circuit Court of Appeals (*Century Distilling Co. v. Continental Distilling Co.*, 106 F. 2d 486) the court affirmed the decision of the lower court holding the marks of the parties to be confusingly similar and dismissed the plaintiff's bill for that reason, but stated, by way of *obiter dicta*, that the absent Commissioner of Patents was not an indispensable party in that particular case.

The decision of the Court of Appeals for the District of Columbia Circuit in the instant case, as clearly stated in its opinion (R. 13-14), follows applicable prior decisions by that court and is squarely in point with its own prior decisions in several cases including the case of *Tomlinson of High Point v. Coe* (74 App. D. C. 364, 123 F. 2d 65 (1941)). If, as the Commissioner contends, there is conflict between the reasoning of the District of Columbia Court of Appeals in the instant case and the reasoning of the Third Circuit Court of Appeals in the Century Distilling case, that same conflict has existed since 1941 (without provoking action by the Commissioner in the public interest to resolve the conflict).

The decisions of the two courts are not however in conflict. The Third Circuit Court of Appeals held in the *Century Distilling* case that the Commissioner of Patents was not an indispensable party in that particular case, while the District of Columbia Court of Appeals in the instant case held that the opposer in the antecedent Patent Office proceedings was not an indispensable party.

The petitioner in the instant case did not in its answer nor in its motion to dismiss, or before the Court of Appeals, contend that the Commissioner of Patents was not a necessary or proper party to the action.

Respondent did not in its briefs below concede, as claimed in the petition (P. 7), "that the rationale and result in the present case are in square conflict with *Century Distilling Co. v. Continental Distilling Co.*, 106 F. 2d 486 (C.A. 3)". In the *Century Distilling* case the plaintiff's bill was dismissed on the ground that the plaintiff's mark was confusingly similar to the defendant's mark and in the *Tomlinson* case (to which respondent referred in its briefs below) the action was ordered to be continued against the Commissioner of Patents as the sole party defendant.

In the court below, the petitioner did not contend that the decision in the *Tomlinson* case was in conflict with the decision of the Court of Appeals in the *Century Distilling* case, nor did he then seek or request a reversal of the prior decision of the court below in the *Tomlinson* case because of any alleged conflict between the circuits.

Whatever opinion conflict there is as to the indispensability of the Commissioner of Patents is between the decision of the Third Circuit Court of Appeals in the *Century Distilling* case and its own prior decision in *Drackett v. Chamberlain* (81 F. 2d 866, C.C.A. 3rd, 1936). In the *Drackett* case, the Third Circuit Court of Appeals dismissed an action brought by an applicant, unsuccessful in antecedent Patent Office trade-mark opposition proceedings, on the ground that the absent Commissioner of Patents was an indispensable party.

That conflict between opinions of the Third Circuit Court of Appeals, the petitioner seeks to resolve by drawing a distinction between the refusal of registration of the Commissioner in opposition proceedings on the ground that applicant's mark is descriptive, and the refusal of registration in opposition proceedings on the ground that applicant's mark is confusingly similar to a prior registered trademark. That distinction obviously finds no support in the Trade-Mark Act of 1905, for Section 5 of that Act (App. 14) authorizes and requires the Commissioner to refuse registration of marks which are descriptive or which are confusingly similar to prior registered or unregistered marks, regardless of oppositions.

The petitioner asserts that sound reason supports the distinction which he seeks to make between the decisions of the Third Circuit in the Drackett case and in the Century Distilling case because the successful opponent in the one case will have a greater self interest than in the other and be therefore a better champion of the public interest in the one case than the other. Why that should be so is not pointed out nor clear to the respondent.

Self interest and public interest are identical in the case of allegedly descriptive marks but may, at least theoretically, diverge in respect to the issues of confusing similarity and priority. Thus, if there be any force whatsoever to the petitioner's reasoning as to self interest, the successful opposer could be relied upon to protect the public interest in the case of marks refused registration in opposition proceedings on the ground of descriptiveness, but would not be likely to protect the public interest in the case of marks refused in opposition proceedings on the grounds of confusing similarity or prior use. In any event, the statute imposes upon the Commissioner, not owners of prior registered marks, the duty of enforcing the prohibitions of the Statute in the public interest and to refuse registrations prohibited by Sec. 5 of the Act, regardless of opposition proceedings. Thus, the consent of the opposer to the regis-

tration of the mark opposed forms no basis for judgment in favor of the applicant for registration. *Martorelli v. Atlantic Macaroni Co.*, 111 F. 2d 494, 27 C.C.P.A. (Patents) 1171 (1940); *Schering and Glatz, Inc. v. Sharp and Dohme, Inc.*, 146 F. 2d 1019, 32 C.C.P.A. (Patents) 827 (1944).

Section 4915 of the Revised Statutes (App. 13) requires the court to give "notice to adverse parties." Obviously, "adverse parties" as used in R.S. 4915 means those parties which are denominated as such in the bill of complaint.

While it may be true that one court at least has held that the opposer in Patent Office trade-mark opposition proceedings may be an "adverse party," if named as such in the bill of complaint, this court and the Courts of Appeals have uniformly held that Section 9 of the Trade-Mark Act of 1905 (App. 13) taken with Section 4915 of the Revised Statutes (App. 13) gives a dissatisfied applicant for registration of a trade-mark a right of action against the Commissioner of Patents following opposition or cancellation proceedings in the Patent Office.

American Steel Foundries v. Robertson, 262 U. S. 209 (1923);

Baldwin Co. v. Robertson, 265 U. S. 168 (1924);

Drackett Co. v. Chamberlain Co., 81 F. 2d 866, C. C. A. 3rd (1936);

Alexandrine v. Coe, 63 App. D. C. 127, 71 F. 2d 348 (1934);

Thorne, Neal & Co., Inc. v. Coe, 143 F. 2d 155, 79 App. D. C. 122 (1944);

Speed Products Co., Inc. v. Tinnerman Products, Inc., 73 U. S. P. Q. 181 (1947);

Speed Products Co., Inc. v. Tinnerman Products, Inc. and Kingsland, 77 U. S. P. Q. 447 (1948);

Tomlinson of High Point v. Coe, 74 App. D. C. 364, 123 F. 2d 65 (1941).

The petitioner contends that if the presence of the Commissioner is required in cases similar to the present one, and if the statute also requires the joining of the opposing party, then access to the courts will be denied to the un-

successful applicant for trade mark registration. The court below held that the opposing party was not indispensable. On the other hand, no court has held that the opposing party in the antecedent Patent Office proceeding is indispensable. Thus on the only issue raised by the petitioner in his motion to dismiss, the decisions of the courts are in strict uniformity and no conflict whatsoever exists.

Confusion of parties litigant as to whether to bring an action under R. S. 4915 against the Commissioner or against a successful opposer in Patent Office trade mark opposition proceedings, is alleged. That is, in all probability, dissipated by the provisions of Sec. 21 of the Trade Mark Act of 1946 (App. 17), but in any event is not the result of the decision in the present case, or of the prior applicable decisions cited by the Court of Appeals of the District of Columbia in its opinion in this case.

Such confusion as has existed arose by reason of the decision of the Court of Appeals of the District of Columbia in *Coe v. Hobart Mfg. Co.*, 70 App. D. C. 2, 102 F. 2d. 270 (1939), holding that a winning party in Patent Office interference proceedings cannot be joined with the Commissioner of Patents as a party defendant in an action brought in the District Court for the District of Columbia. The present case is clearly not an appropriate vehicle for the consideration by this court of that issue, the decision of which has created such confusion and will continue to create such confusion regardless of any decision which might be rendered in the present case on the question presented to this court.

Before the court below, counsel for the Commissioner of Patents stated, as noted in the court's opinion (R. 14), that the Commissioner had no interest one way or the other in the outcome of the appeal except that the Commissioner desired that the matter be cleared up and settled by that court. The Commissioner's disinterest in the decision of the issue at that time is hardly compatible with his present protestations of the general public importance of the same.

It is alleged by petitioner that the broad ground upon which the decision below rests make it applicable to all proceedings under R. S. 4915, patent as well as trade mark cases. However, such is not the fact for the court expressly limited its decision to the issue of whether an opposer in an antecedent Patent Office trade mark opposition proceeding is an indispensable party to an action under Section 4915. The court did not discuss or even intimate any decision, one way or the other, as to whether the Commissioner of Patents would be an indispensable party to actions brought under Section 4915 of the Revised Statutes following patent interference proceedings in the Patent Office. It is noted that Petitioner mentions the fact of at least one patent case filed under Section 4915 in accordance with the Barron-Gray decision and it would appear that such a patent case properly presents this question for the Court of Appeals to subsequently determine whether its decision in the instant Barron-Gray trade mark case is applicable to patent cases.

There is a clear distinction between actions brought under Section 4915 of the Revised Statutes following Patent Office patent interference proceedings and actions brought under the same Section following Patent Office trade mark opposition proceedings. Patent interference proceedings are essentially inter-partes in nature for the issue is one of priority between the interfering parties. The usual trade mark opposition proceeding under Section 6 the Trade Mark Act of 1905 (App. 16) is essentially ex parte in nature for the chief, and frequently the only, issue is the registrability of the mark to the plaintiff under the provisions of Sec. 5 of that Act (App. 14). The petitioner therefore makes a tremendous, and unwarranted, assumption in its assertion that the decision in the present case may subsequently be held to be applicable to actions under Section 4915 following patent interference proceedings in the Patent Office.

Such confusion as exists in trade mark proceedings, to which the present case alone relates, is now dissolved by the provisions of Sec. 21 of the Trade Mark Act of 1946 (App. 17), which on its effective date of September 1, 1947 superseded the Trade Mark Act of 1905 under which the present action was brought and under which the instant case must be decided.

There is a still further ground justifying refusal of the writ. The petition is presented to this court for the review of a decision of the court below on a motion to dismiss whereby the dismissal ordered by the District Court was reversed and the case remanded for trial. Review of the case by this court at this interlocutory stage of its development may not be timely or appropriate (*Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U. S. 251; Cf. *United States Alkali Export Association, Inc. v. United States*, 325 U. S. 196).

CONCLUSIONS.

1. There is no conflict between decisions of courts of appeals of different circuits on the question presented.

2. The question decided by the Court of Appeals is not of general importance because:

- (a) The question presented to this court is in itself not likely to arise hereafter in view of superseding Section 21 of the Trade Mark Act of 1946 (App. 17) governing future actions in trade mark matters under Section 4915 of the Revised Statutes (App. 13);
- (b) The applicability of the decision below to actions in patent interference matters under R. S. 4915 was not decided by the Court of Appeals nor does the reasoning of the Court compel the conclusion that it is applicable to those matters;
- (c) The instant case does not provide an appropriate vehicle for the decision of another interesting question—not put in issue below but mentioned in the opinion of the court below by reference to its

own prior decisions not challenged by the petitioner.

3. Review of the case by this court at this time would be premature or inappropriate.

Respectfully submitted,

BALLARD MOORE,
CURTIS F. PRANGLEY,
CHARLES L. STURTEVANT,
Counsel for Respondent.

Dated: March 4, 1949.

APPENDIX.**Statutes Involved.**

Section 9 of the Trade Mark Act of 1905 (Act of February 20, 1905, c. 592, Sec. 9, 33 Stat. 727; Act of March 2, 1929, c. 488, Sec. 2(b), 45 Stat. 1476); 15 U. S. C. A., Section 89:

That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of patents, he may appeal to the United States Court of Customs and Patent Appeals, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

Revised Statutes, Title LX: Sec. 4915, (U. S. C., title 35, sec. 63) (Amended by Act of February 9, 1893, c. 74, sec. 9, 27 Stat. 436; March 2, 1927, c. 273, sec. 11, 44 Stat. 1336; March 2, 1929, c. 488, sec. 2(b), 45 Stat. 476; August 5, 1939, c. 451, sec. 4, 53 Stat. 1212.)

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case

may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Section 737 of the Revised Statutes (Act of Mar. 3, 1911, c. 231, Sec. 50, 36 Stat. 1101), 28 U. S. C. A. Section 111:

When part of several defendants cannot be served. When there are several defendants in any suit at law or equity, and one or more of them are neither inhabitants of nor found within the district in which the suit is brought, and do not voluntarily appear, the court may entertain jurisdiction, and proceed to the trial and adjudication of the suit between the parties who are properly before it; but the judgment or decree rendered therein shall not conclude or prejudice other parties not regularly served with process nor voluntarily appearing to answer; and nonjoinder of parties who are not inhabitants of nor found within the district, as aforesaid, shall not constitute matter of abatement or objection to the suit.

Section 5 of the Trade-Mark Act of 1905 (Act of February 20, 1905, c. 592, Sec. 5, 33 Stat. 725; Act of March 2, 1907, c. 2573, Sec. 1, 34 Stat. 1251; Act of February 18, 1911, c. 113, 36 Stat. 918; Act of January 8, 1913, c. 7, 37 Stat.

649; Act of March 19, 1920, c. 104, Sec. 9, 41 Stat. 535; Act of June 7, 1924, c. 341, 43 Stat. 647) 15 U. S. C. A. Section 85:

That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, *or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: Provided*

further, That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing, nor may the portrait of any deceased President of the United States be registered during the life of his widow, if any, except by the consent of the widow evidenced in such manner: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five: *Provided further*, That nothing herein shall prevent the registration of a trade-mark otherwise registerable because of its being the name of the applicant or a portion thereof.

And if any person or corporation shall have so registered a mark upon the ground of said use for ten years preceding February 20, 1905, as to certain articles or classes of articles to which said mark shall have been applied for said period, and shall have thereafter and subsequently extended his business so as to include other articles not manufactured by said applicant for ten years next preceding February 20, 1905, nothing herein shall prevent the registration of said trade-mark in the additional classes to which said new additional articles manufactured by said person or corporation shall apply, after said trade-mark has been used on said article in interstate or foreign commerce or with the Indian tribes for at least one year **provided** another person or corporation has not adopted **and used** previously to its adoption and use by the **proposed** registrant, and for more than one year such trade-mark or one so similar as to be likely to deceive in such additional class or classes.

Section 6 of the Trade Mark Act of 1905 (Act of February 20, 1905, c. 592; Sec. 6, 33 Stat. 726; Act of Mar. 2, 1907, c. 2573, Sec. 2, 34 Stat. 1252) 15 U. S. C. A. Section 86:

That on the filing of an application for registration of a trade-mark which complies with the requirements of this act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of this act, the commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this act. An opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing. If no notice of opposition is filed within said time, the commissioner shall issue a certificate of registration therefor, as herein-after provided for. If on examination an application is refused, the commissioner shall notify the applicant, giving him his reasons therefor.

Sec. 21 of Trade Mark Act of 1946. (15 U. S. C. Section 1071)

SEC. 21. Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, or any registrant who has filed an affidavit as provided in section 8, who is dissatisfied with the decision of the Commissioner may appeal to the United States Court of Customs and Patent Appeals or may proceed under section 4915, Revised Statutes, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable: *Provided*, That any party who is satisfied with the decision of the Commissioner shall, upon the filing of an appeal to the Court of Customs and Patent

Appeals by any dissatisfied party, have the right to elect to have all further proceedings under Revised Statutes 4915, by election as provided in Revised Statutes 4911. The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under Revised Statutes 4915, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action.